

## **REMARKS**

### **July 10, 2007 Office Action**

This Amendment and Response is submitted in response to the July 10, 2007, Office Action in which the Amendment and Response filed on May 16, 2007, was held non-responsive to the April 13, 2007, Office Action because the newly submitted claims were directed to an invention that is independent or distinct from the invention originally claimed in U.S. Patent 5,566,486, and because all claimed drawn to the elected invention were cancelled.

### **September 3, 2004 Office Action**

This Amendment and Response is in response to the September 3, 2004, Office Action.

#### **Drawings**

In paragraph 3 of the Office Action, the Examiner references 37 C.F.R. §121 (b)(3)(I) in disapproving the changes to FIG. 2. However, 37 C.F.R. §121 (b)(3)(i) reads:

- (3) Amendment by substitute specification . The specification, other than the claims, may also be amended by submitting:
  - (i) An instruction to replace the specification;

In view of the continued reference in the Office Actions to Regulations which either no longer exist or an inapplicable to the figures, Applicant has revised the specification to omit any reference to numeral 30, thus overcoming the objections to the drawings and obviating any need to amend Figure 2.

#### **Prior Art Rejections**

In the September 3, 2004, Office Action, paragraphs 7-8, the Examiner rejected claims 1-2, 4-6, 9, 12-15, 18, 21, 28, 32, 33, 38, 39, 42, 43, 45-47, 50, 53-56, 59, 62 and 67 under 35

U.S.C. 102(b) as being anticipated by Johnson '704. None of these claims are currently pending in the application, so this rejection is moot.

In the September 3, 2004, Office Action, paragraph 9, the Examiner rejected claims 28, 32, 33 and 67 under 35 U.S.C. 102(b) as being anticipated by Horne '307. None of these claims are currently pending in the application, so this rejection is moot.

### **Recapture**

The Examiner rejected all previously pending claims under 35 U.S.C. § 251 as being “an improper recapture of claimed subject matter because the claim language is directed to subject matter surrendered in the original application by changes made to the claims in an effort to overcome a prior art rejection and/or arguments made in an effort to overcome the prior art”. In support of this rejection, the Examiner relies specifically on the following claim language which was added by amendment during prosecution of the original patent:

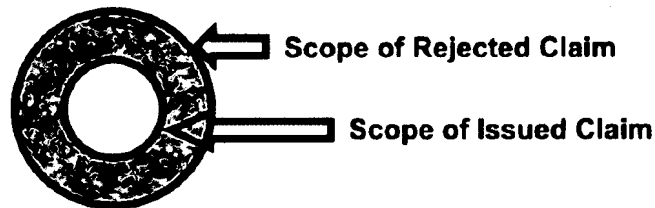
1. “for attaching to a firearm, said firearm having a firing end and a grip end, and”, added to the preamble of issued claim 1 (original application claim 1).
2. “wherein said first means comprise an inertia switch comprising a movable mass; and wherein said mass is resiliently biased toward the firing end of the firearm” added to issued claims 1 and 14 (original application claims 1 and 12).

The Examiner also relies upon “arguments filed on 2/20/96 directed to ‘the moveable mass is resiliently biased toward the firing end of the firearm’”.

The Examiner’s recapture rejection in the September 3, 2004, Office Action, is taken verbatim from part of paragraph 15 of the November 11, 2000. However, in the years between the two Office Actions, and subsequent to the cases cited in the November 11, 2000 and September 3, 2004, Office Actions, the Board of Patent Appeals rendered its decision in *Ex parte Eggert*, 67 U.S.P.Q. 2d 1716 (Bd. Of Patent Appeals and Interferences, 2003), completely in accordance with Applicant’s statement of the recapture rule as set forth in Applicant’s previously submitted Remarks.

The BPAI summarized the recapture rule as “[a] patentee is precluded from recapturing in reissue that which he earlier conceded was unpatentable and abandoned or surrendered, whether by cancellation or argument of claims for the purpose of obtaining the original patent”.

*Id.* at 1723. The BPAI made it clear that the scope of surrendered subject matter is defined entirely by the scope of the “claim from which the issued claimed (sic) directly evolved, not the issued claim itself”, *Id.* at 1718, using the following drawing to explain the scope of surrendered subject matter:



**Drawing 1**

The BPAI indicated that “the surrendered subject matter is the outer circle of Drawing 1 because it is the subject matter which appellants conceded was unpatentable. ... Thus, appellants have never conceded that a claim falling within the scope of the shaded area of Drawing 1 is unpatentable and therefore, in our view, such subject matter is not barred by the recapture rule.”. *Id.* at 1717. The BPAI provided an example: “... if an outer circle claim contains elements ABC and the inner circle claim contains elements ABCDEF, a reissue applicant cannot recapture a claim directed to elements ABC (outer circle) or a claim entirely outside the outer circle (e.g., AB, BC, ABC<sub>BR</sub><sup>2</sup>, etc.). However, it is our view that the reissue recapture rule is not invoked for claim directed to elements ABCX, ABCD<sub>BR</sub>, ABCEF, A<sub>BR</sub>BCDEF.” *Id.* at 1718.

In *Ex parte Eggert*, the examiner contended that “the recapture rule prohibits a patentee from obtaining in reissue any claim which does not include each and every limitation added to a claim or argued by an applicant during the prosecution of the original patent application in order to overcome a rejection and obtain a patent ...” (citations omitted), *Id.* at 1723. The BPAI noted that “[t]his approach ... has been expressly rejected by the Court of Customs and Patent Appeals (CCPA) and the Court of Appeals for the Federal Circuit (Federal Circuit)” *Id.* at 1723. It is clear that surrendered subject matter does not include limitations added or argued in the last amendment to the claims that became the issued claims.

### **Subject Matter Surrendered In The Original Application**

In the original application, only two independent claims were filed in the original patent, original application claims 1 and 12 (which became issued claim 14). Original application claims 1 and 12, as filed, differ from each other only in the preamble, in that claim 1 is directed to a firearm monitoring device and claim 12 is directed to the combination of a firearm with a monitoring device. The bodies of both original application claims are identical. Because of the similarity of these claims, Applicant will only specifically discuss original application claim 1.

1. A firearm monitoring device, said firearm being susceptible to recoil when discharged, comprising:

- a) first means for creating a first signal in response to substantially each recoil of said firearm; and
- b) second means for receiving each said first signal and generating a second signal indicative of the number of said first electrical signals received by said second means.

The original claims were rejected in the October 10, 1995, Office Action. In response, claims 1 and 12 were amended. Claim 1 was amended as follows:

1. (Amended) A firearm monitoring device for attaching to a firearm, said firearm having a firing end and a grip end, and said firearm being susceptible to recoil when discharged, comprising:

- a) first means for creating a first signal in response to substantially each recoil of said firearm; and
- b) second means for receiving each said first signal and generating a second signal indicative of the number of said first electrical signals received by said second means;

wherein said first means comprise an inertia switch comprising a movable mass; and

wherein said mass is resiliently biased toward the firing end of the firearm.

Claim 12 was similarly amended.

For purposes of the recapture rule as applied to any of the pending claims, the surrendered subject matter is that of claim 1 as originally submitted. Using the nomenclature of the BPAI in *Eggert*, the outer circle consists of A (first means for creating a first signal in response to substantially each recoil of said firearm) and B (second means for receiving each said first signal and generating a second signal indicative of the number of said first electrical signals received by said second means). To obtain allowance, elements C (for attaching to a firearm), D (said firearm having a firing end and a grip end), E (wherein said first means comprise an inertia switch), F (comprising a movable mass), G (wherein said mass is resiliently biased) and H (toward the firing end of the firearm) were added. The inner circle consists of ABCDEFGH.

**Claims 22, 27, 29 and 63**

Claim 22 reads:

Element	Claim 22
	A firearm monitoring device
	for use with a firearm, comprising:
A	an inertia sensor configured to generate at least one first signal in response to substantially each discharge of said firearm;
B	an electrical circuit configured to receive said at least one first signal generated by said inertia sensor and generate a second signal indicative of the number of firearm discharges
X	said electrical circuit configured to ignore any signals generated by said inertia sensor within a predetermined time period following the generation of an initial one of a series of said first signals

Claim 22 is represented by ABX, where X is a new element not present in the surrendered subject matter. Claim 22 has all the limitations of the surrendered subject matter of claim 1. The BPAI clearly indicated that this claim is not subject to the recapture rule: As discussed above, the BPAI stated that when the scope of surrender is AB, ABX does not invoke the recapture rule. CDEFGH are not required to be included to avoid the recapture rule.

Thus, claim 22, and claims 23-26, 31 and 40 dependant therefrom, do not invoke the recapture rule, and are allowable in this application.

Claim 63 reads:

Element	Claim 63
	A firearm monitoring device
	for use with a firearm, comprising:
A	an inertia switch configured to generate at least one first signal in response to substantially each discharge of said firearm;
B	an electrical circuit configured to receive said at least one first signal generated by said inertia switch and generate a second signal indicative of the number of firearm discharges
X	said electrical circuit configured to ignore any signals generated by said inertia switch within a predetermined time period following the generation of an initial one of a series of said first signals

Claim 63 is represented by ABX, where X is a new element not present in the surrendered subject matter. Claim 63 has all the limitations of the surrendered subject matter of claim 1. The BPAI clearly indicated that this claim is not subject to the recapture rule: As discussed above, the BPAI stated that when the scope of surrender is AB, ABX does not invoke the recapture rule. Other limitations are not required to be included to avoid the recapture rule.

Thus, claim 63, and claims 64-66 dependant therefrom, do not invoke the recapture rule, and are allowable in this application.

Claims 27 and 29 are directed to inventions which were not claimed in the original prosecution of the issued patent. Claim 27 is directed to a firearm monitoring device with an accelerometer and a circuit that determines whether the firearm has been discharged based solely on receipt of a first signal. Claim 29 is directed to a device for counting impulses and a circuit that ignores subsequent signals that follow the first signal within a predetermined time period.

The issue with respect to claims 27 and 29, and any claims dependant therefrom is whether these claims are directed to subject matter that the Applicant “conceded was unpatentable and abandoned or surrendered, whether by cancellation or argument of claims for the purpose of obtaining the original patent”. *Id.* at 1723. The patent specification discloses several inventions and several embodiments. In addition to the firearm monitor, the specification discloses the use of the teachings of the inventions as an impulse monitor. It discloses that the circuit can be configured to ignore multiple closures occurring within a predetermined period of time.

None of these inventions were ever the subject of any claims presented during the original prosecution. Thus, it is impossible for the Applicant to have conceded they were unpatentable, or to have abandoned or surrendered them for purposes of obtaining the patent.

The key under the recapture rule is regaining that which was surrendered in an effort to obtain allowance of the original claims. “The recapture rule ... prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims”. In re Clement, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997). Surrender requires not only that there be intent to give up the subject matter, but that the subject matter actually be given up.

It is axiomatic that to surrender subject matter in an effort to obtain allowance of the original claims, the subject matter must be in the claims surrendered (whether by amendment to those claims, or by argument). The subject matter of claims 27, 29, 34, 35 and 41 was never presented, and therefore never surrendered. Thus, the recapture rule does not apply.

### **Previous Remarks**

In the previous remarks filed by Applicant on August 19, 2001, Applicant erroneously indicated that:

1. Inertia switch is broader than first means for creating a first signal (applying §112, ¶6 construction).

2. Inertia sensor is broader than first means for creating a first signal (applying §112, ¶6 construction).
3. Accelerometer is broader than first means for creating a first signal (applying §112, ¶6 construction).
4. An electrical circuit is broader than second means for receiving and generating (applying §112, ¶6 construction).

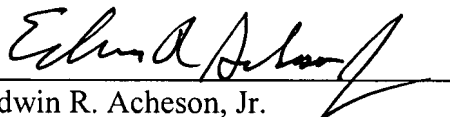
It is clear that under §112, ¶6, and Applicant expressly states that, first means for creating a first signal is broader than an inertia switch, an inertia sensor and an accelerometer for creating a first signal. It is also clear that under §112, ¶6, and Applicant expressly states that, second means for creating a first signal is broader than an electrical circuit for receiving and generating.

#### **Conclusion**

Applicant believes that of the Examiner's rejections must be withdrawn and that all of the claims are in condition for allowance. Applicant respectfully requests that the Examiner withdraw the rejections and allow this application.

Respectfully submitted,

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this 13<sup>th</sup> day of November, 2007.

Carol Ann Miller